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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/555,630 | 07/06/2000 | HIROSHI OKUBO | 106348 | 1399 |

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| EXAMINER | |
|---|---|
| ONEILL, MICHAEL W | |
| **ART UNIT** | **PAPER NUMBER** |
| 3713 | 14 |

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/555,630 | OKUBO ET AL. | |
| | Examiner | Art Unit | |
| | Michael O'Neill | 3713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) *13-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 25-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of claims 1-12 and 25-36 in Paper No. 13 is acknowledged. The traversal is on the ground(s) that the Examiner improperly applied the procedures for Restriction Requirements when dealing the applications that have been filed the appropriated provisions with the regulations. This is not found persuasive because in the admininstrative instructions under the PCT, Annex B, Unity of Invention, Part 1, Instructions Concerning Unity of Invention, Paragraph (b) states:

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. **The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.** The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

As shown below in the art rejections, the claimed inventions have no special technical features. Therefore, the is no unity of invention. And therefore, the requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11, 12, 25-28, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipate by Okada et al. USPN 5,668,601.

Because of the unconventional terminology the Applicants have used to described and claim the Applicants' invention, the Examiner will try to correlate the claimed limitations to the common terminology utilized by the prior art. As shown in Fig. 13A there is disclosed to one skilled in the art a system stream etched into an optical disk (not shown). In the instant disclosure the disk can be a video CD or DVD. The stream contains audio data A1, A2 and A3 and video data V1-V6. Within the audio data A1 there is a presentation time stamp PTS(A1); likewise within video data V1 and V6 there are presentation time stamps PTS(V1) and PTS(V6) respectively. The PTS(A1), PTS(V1),

PTS(V6) and SCR are utilized by the audio and video decorders to synchronize the audio output and video output respectively. The limitation of the reproduction means is met by the decoders. The processing means is met by the A/V parser. The "capable of being accessed simultaneously is met by what is shown in Fig. 13A as one pack. The elapsed time limitations is met by the PTSs disclosed therein. The limitations found in claims 11, 12 35 and 36 is the whole purpose of an audio-video decoder: to make sure that the audio is in sync with the video.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-10 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al., USPN 5,668,601.

These claims give the preamble in the independent claims meaning. However, the limitations recited in the claims are well-known items in game machine. Okada et al. discloses that the invention therein is part of a home enterntainment system. The term "home enterntainment system" encompasses video game machines to those of ordinary skill in the art. Therefore, to incorporate the decoding system disclosed in Okada et al. would be obvious to those of ordinary skill in the art.

New claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. USPN 5,668,601.

These claim limitations are known to those skilled in the art as background music (BGM). BGM is utilized by those skilled in the art to enhance the gaming experience. BGM is usually well known music tunes to the audience that the video game designers are catering their video game to. BGM is usually played during the opening credits of a video game thus presenting a "music video" to the audience; usually it is the "theme song" to the video game. Different BGM is played while

the game is progressing and changes with the change in game tempo. Therefore, the limitations within these claims are obvious to one of ordinary skill in the art.

***Response to Arguments***

The Examiner respectfully disagrees with the undersigned regarding the restriction requirement.

The Examiner agrees with the undersigned that Takamori does not clearly show the SCR and PTS within audio or video data. Therefore, the Examiner conducted a further search of the prior art and found a reference, Okada et al., USPN 5,668,601, that does clearly show PTS within the audio and video data, see figure 13A in Okada et al. Also, unless the Applicant has devised a different way optical disk data is read, Okada et al. also reads on the simultaneous reading of the sync and audio or video data.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J. Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.

MON

MICHAEL O'NEILL
PRIMARY EXAMINER